

In re Application of: Dror HARATS et al
 Serial No.: 10/567,543
 Filed: April 25, 2008
 Office Action Mailing Date: June 15, 2010

Examiner: Rei Tsang Shiao
 Group Art Unit: 1628
 Attorney Docket: 31532
 Confirmation No.: 8510

REMARKS

Reconsideration of the above-identified application in view of the amendments above and the remarks following is respectfully requested.

Claims 91-199 are in this Application. Claims 91-199 have been examined on the merits, with claims 91-99, 104-135, 140-151 and 156-199 reading on the elected species. Claims 1-90 have been canceled in a previous response. Claims 94-97, 130-133, 141, 142 and 179-192 have been canceled herewith. Claims 91, 98, 128, 134, 140, 143, 145, 152, 154, 156, 193, 194 and 197-199 have been amended herewith. New claims 200-221 have been added herewith.

Amendments To The Claims

Claim Objections

The Examiner has stated that claims 184-185, 191-192 and 198-199 are objected to because a symbol ":" is missing at the end of each claim.

Claims 198-199 have been amended so as to include a period at the end of each claim.

Claims 184-185 and 191-192 have been canceled without prejudice.

Applicant therefore believes to have overcome the Examiner's objection.

35 U.S.C. § 112 Rejections

The Examiner has stated that claims 140-178 and 193-199 are rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for treating inflammation using oxidized lipid compounds of Formula I, does not reasonably provide enablement for preventing inflammation using oxidized lipid compounds with no named compounds or formula.

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The Examiner has further stated that this rejection can be overcome by deletion of “preventing” and incorporation of the limitation of Formula I into claim 140.

In accordance with the Examiner’s suggestion, claim 140 has been amended so as to incorporate the general Formula I recited in claim 142, and to no longer recite “preventing”.

As a result of the amendments to claim 140, claims 141 and 142 have been canceled without prejudice. Consequently, claims 143, 145, 152, 154 and 156 have been amended so as to depend from claim 140 instead of from canceled claim 142.

Applicant therefore believes to have overcome the Examiner’s rejections.

Double Patenting Rejections

The Examiner has stated that claims 91-139 and 179-192 are rejected on the ground of non-statutory obviousness-type double patenting over claim 1 of U.S. Patent No. 6,838,452.

A terminal disclaimer in compliance with 37 CFR 1.321(c), and which overcomes the Examiner’s rejections, is enclosed herewith.

Additional Amendments

Applicant has made some further amendments to the claims, in order to correct minor errors and improve the clarity and readability of the claims. Applicant submits that the amendments do not affect the scope of the claims.

Thus, claim 91 has been amended so as to recite “phosphorus” instead of “phosphor”, “biphosphonate” instead of “biposphonate”, and “phosphoglycerol” instead of “phsophoglycerol”, thereby correcting typographical errors.

Similarly, claim 193 has been amended so as to recite “phosphoryl” instead of “phsophoryl”.

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Claim 197 has been amended to recite 1-Hexadecyl-2-(4'-carboxy-butyl)-sn-glycero-3-phosphocholine and 3-Hexadecyl-2-(4'-Carboxy-butyl)-sn-glycero-1-phosphocholine instead of 1-Hexadecyl-2-(5'-Carboxy-butyl)-sn-glycero-3-phosphocholine and 3-Hexadecyl-2-(5'-Carboxy-butyl)-sn-glycero-1-phosphocholine (emphasis added).

It is submitted that this amendment is a correction of an obvious error, in view of the structural formula corresponding to the compounds recited in claim 197, and which is presented in Figure 10 of the instant application as originally filed, and further in view of the fact that a butyl group has only 4 carbon atoms.

Claim 194 has been amended to recite “m equals 15” instead of “m equals 16” (with regard to X₁), and “m equals 3” instead of “m equals 4” (with regard to X₂).

It is submitted that the above amendments are corrections of obvious-to-correct errors, as evidenced, for example, by the fact that claim 197, which depends from claim 194, recites compounds (i.e., 1-Hexadecyl-2-(4'-Carboxy-butyl)-sn-glycero-3-phosphocholine and 3-Hexadecyl-2-(4'-Carboxy-butyl)-sn-glycero-1-phosphocholine) which correspond to compounds according to Formula I, wherein the variable m equals 15 for X₁ (rather than 16), and 3 for X₂ (rather than 4).

Claim 91 has been further amended so as to recite “if n=1, C_n, B_n, R_n and Y are absent” instead of “if n=1, C_n, B_n, R_n, R'n and Y are absent” (emphasis added).

Applicant believes that the recitation of R_n and R'_n as being absent is an obvious-to-correct error, as the valence requirements of C₁ require only one of R_n and R'_n to be absent. Applicant wishes to note in this respect that the variables R_n and R'_n are equivalent (i.e., have identical definitions) and therefore it is arbitrary whether R_n or R'_n is absent when n=1.

It is noted that the abovementioned amendments to claim 140, which introduce limitations similar to those recited in claim 91, have been made so as not to include the abovementioned errors.

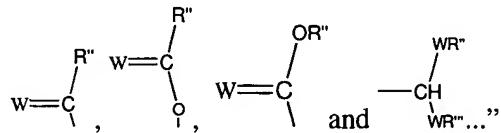
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Claim 128 has been amended so as to depend from claim 104 instead of from claim 14.

It is submitted that the above amendment is a correction of an obvious typographical error, as evidenced, for example, by the fact that claim 14 is canceled, by the similarity between "104" and "14", and by the fact that original claim 39, which recited subject matter corresponding to that of claim 128, depended from original claim 15, which recited subject matter corresponding to that of claim 104.

In addition, Applicant has chosen to amend claim 91 so as to further characterize the recited compound. Thus, claim 1 has been amended so as to recite "whereas when n=3, A₂ is CR"R""..." and "wherein if n=3, X₂ comprises a Z selected from the group consisting of:



The above amendments to claim 91 are supported for example, by claims 95 and 97.

As a result of the above amendments to claim 91, claims 95, 97, 131 and 133, which recite limitations made redundant by the above amendments to claim 91, have been canceled without prejudice.

Applicant has further chosen to cancel claims 94, 96, 130, 132, 179-183, and 186-190 without prejudice.

As a result of the cancellation of claims 94 and 97, claim 98 has been amended so as to depend from claim 91 instead of from claim 97, and to recite the limitations recited in canceled claim 94.

Similarly, as a result of the cancellation of claims 130 and 133, claim 134 has been amended so as to depend from claim 104 instead of from claim 133, and to recite the limitations recited in canceled claim 130.

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Thus, claims 98 and 134 recite “wherein n equals 3, and X₂ comprises a Z selected from...”.

New claims

New claims 200-221 are introduced herewith, with claims 200-204 and 209-217 reading on the elected species.

New claim 200 reads on subject matter similar to amended claim 91, and recites that Y in the general formula is a phosphoryl derivative.

Applicant wishes to note in this regard that the instant application refers throughout to oxidized phospholipids (see, for example, page 30, lines 22-26, and page 31, lines 9-13, therein).

New claims 201-221 depend from new claim 200, and recite limitations recited similar to those of claims 92, 93, 98-106, 126-129, and 134-139, which depend from claim 91.

Examination of Generic and Non-Elected Claims

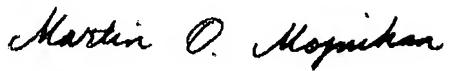
In view of the arguments and amendments recited herein it is believed that the claims are allowable with respect to the elected species and hence examination of all claims in this Application in their generic context and with respect to all the species recited therein is respectfully requested.

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In view of the above amendments and remarks it is respectfully submitted that claims 91-93, 98-129, 134-140, 143-178 and 193-221 are now in condition for allowance. A prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,



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Date: September 14, 2010

Enclosures:

- Additional Claims Transmittal Fee
- Terminal Disclaimer (re: U.S. Patent No. 6,838,452)